



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/365,241	07/30/1999	THOMAS BRODIN	003300-581	1539

21839 7590 03/19/2002

BURNS DOANE SWECKER & MATHIS L L P  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
----------

PONNALURI, PADMASHRI

ART UNIT	PAPER NUMBER
----------	--------------

1627

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
**09/365,241**

Applicant(s)  
**Brodin et al**

Examiner  
**Padmashri Ponnaluri**

Art Unit  
**1627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9, 10, 17-27, 29, 33-57, and 61-64 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-4, 6, 7, 9, 10, 17-27, 29, 33-57, and 61-64 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1627

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/02 has been entered.

2. The after final amendment filed on 11/19/01 has been fully considered and entered into the application.

3. Claims 28, 30-32 and 58-60 have been canceled by the amendment D, filed on 11/19/01.

4. Claims 1-4, 6-7, 9-10, 17-27, 29, 33-57 and 61-64 are currently pending in this application.

5. Upon further consideration, the claims have been restricted (species election) as following.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Art Unit: 1627

*Election/Restriction*

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

Applicants are requested to elect a single species election for each of the following:

- a) target;
- b) target structures (ligand, receptor, adhesion molecule, matrix associated molecule, and vasculature targets);
- c) physiological process
- d) in © pathological process is elected, applicants are requested to elect a single species of pathological process;
- e) location of the target structures (i.e., intra cellularly, extracellularly, intranuclear, cell surface);
- f) tissue type (bone marrow cells, lymph cells, sperm cells, cells from cerebrospinal fluid);
- g) type of initial library;
- h) if the initial library is a combinatorial library, how the library is produced by immunization against one or more target strictures, or a chemical library);
- I) amplifying step (using bacterial cells, PCR synthesis, or chemical synthesis);
- j) genetic information;
- k) method of acquiring (i.e., identifying, producing, characterizing, selecting, enriching or defining);
- l) target structure displayed as (i.e, authentic cellular epitope, phenotypic epitope);

Art Unit: 1627

m) cleavage site;

n) protease (i.e., Ala64-subtilisin, blood clotting factor Xa).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 24-27, 33-34, 36-37, 47-51, 54-56 and 65 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1627

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Art Unit: 1627

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627  
15 March 2002

  
**PADMASHRI PONNALURI**  
**PRIMARY EXAMINER**



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: **P. Ponnaluri**

ART UNIT: **1627**

SERIAL NUMBER: 09/365,241

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

THE DOCUMENT(S) ACCOMPANYING THIS FACSIMILE TRANSMISSION CONTAIN(S) INFORMATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH IS CONFIDENTIAL AND/OR LEGALLY PRIVILEGED. THIS INFORMATION IS FOR THE USE OF THE INDIVIDUAL OR FIRM NAMED ON THIS SHEET. IF YOU ARE NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISCLOSURE, COPYING, DISTRIBUTION, OR THE TAKING OF ANY ACTION IN RELIANCE ON THE CONTENTS OF THIS INFORMATION IS STRICTLY PROHIBITED. THE DOCUMENTS SHOULD BE RETURNED TO THE PATENT AND TRADEMARK OFFICE IMMEDIATELY. IF THIS FACSIMILE IS RECEIVED IN ERROR, PLEASE NOTIFY THE ATTORNEY LISTED HEREON IMMEDIATELY.